

Remarks

The Final Office Action dated November 3, 2010, notes that claims 9 and 19 are allowed, and maintains the following rejections: claims 1-8 and 10-18 stand rejected under 35 U.S.C. 103(a) over Thierry Roz (WO 99/60510) in view of Shigyo (U.S. Patent No. 6,430,209) and further in view of Raphaelli (U.S. Patent Pub. 2007/0109099); and claims 20-26 stand rejected under 35 U.S.C. § 103(a) over the '510 reference in view of the '099 reference. In the following discussion, Applicant does not acquiesce in any regard to averments in the Advisory Action or the Office Actions of record (unless Applicant expressly indicates otherwise).

Applicant requests the removal of finality as the current Office Action includes new grounds of rejection, not necessitated by an amendment. As Applicant alerted the Examiner in responding to the previous rejection, new assertions of correspondence are new grounds of rejection, making the finality of the current office action improper. *Hyatt v. Dudas*, 551 F.3d 1307, 1312 (Fed. Cir. 2008) (“a ‘ground of rejection’ for purposes of Rule 1.192(c)(7) is not merely the statutory requirement for patentability that a claim fails to meet but also the precise reason why the claim fails that requirement”). In responding to Applicant’s previous arguments, the Office Action, for the first time, asserts that the interrogation signal 20 of the '099 reference corresponds to the claimed confirm command and that the '099 reference also teaches a different integration signal including a short repeat message that corresponds to the claimed repeat command not containing synchronization information. As Applicant has not had adequate time to respond to these arguments, and the newly presented arguments were not necessitated by an amendment, Applicant respectfully requests the finality of the current Office Action be withdrawn.

Applicant traverses the § 103(a) rejection of claims 20-26 because the cited '510 reference either alone or in combination with the '099 reference lacks correspondence to the claimed invention. For example, neither of the asserted references teaches the claimed invention “as a whole” (§ 103(a)) including aspects regarding, *e.g.*, a confirm command signal not containing synchronization information. More specifically, the Office Action acknowledges that the '510 reference does not teach claimed aspects directed to the MUTE signal (the asserted confirm command signal) not containing synchronization. Further, the '099 reference appears to teach an interrogation signal that does not contain synchronization information. However, the interrogation signal does not

perform the function of the confirm command, and therefore cannot correspond to the claimed confirm command not containing synchronizing information. Because neither reference teaches aspects of the claimed invention directed to a confirm command signal not containing synchronization information, no reasonable interpretation of the asserted prior art, taken alone or in combination, can provide correspondence. Accordingly, the § 103(a) rejection of claims 20-26 fails and Applicant requests that it be withdrawn.

Applicant further traverses the § 103 rejection of claims 20-26 because the cited references teach away from the Office Action's proposed combination. Consistent with the recent Supreme Court decision, M.P.E.P. § 2143.01 explains the long-standing principle that a § 103 rejection cannot be maintained when the asserted modification undermines either the operation or the purpose of the main ('510) reference - the rationale being that the prior art teaches away from such a modification. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (U.S. 2007). ("[W]hen the prior art teaches away from combining certain known elements, ..."). Applicant submits that the combination would render the embodiment of the '510 reference inoperable for its intended purpose because the Office Action's asserted hypothetical embodiment appears to replace the MUTE command of the '510 reference with an interrogation signal. Without the confirm command, each of the devices would respond to each repeat command, resulting in an embodiment unable to identify each individual device and resolve multiple reply signals. For at least these reasons, the asserted hypothetical combination of the '510 reference and the '099 reference is inoperable. Under M.P.E.P. § 2143.01, the rejections cannot stand.

Applicant respectfully traverses the § 103 rejection of claims 1-8 and 10-18 because the cited references teach away from the Office Action's proposed combination. Consistent with the recent Supreme Court decision, M.P.E.P. § 2143.01 explains the long-standing principle that a § 103 rejection cannot be maintained when the asserted modification undermines either the operation or the purpose of the main ('510) reference - the rationale being that the prior art teaches away from such a modification. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (U.S. 2007). ("[W]hen the prior art teaches away from combining certain known elements, ..."). Applicant submits that the combination would render the invention inoperable because the Office Action's asserted hypothetical embodiment includes shutting off control logic 302 when it is detected that the transponder TR_i is in sync with the reading device. *See Office Action at page 6.*

However, "modulator 306 is controlled by a control logics 302 coupled to memory 304." See '510 reference at page 10. If the control logics 302 is off it cannot control the modulator 306, and transmission of the encoding data will not occur. For at least these reasons, the asserted hypothetical combination of the '510 reference, the '209 reference and the '099 reference is inoperable. Under M.P.E.P. § 2143.01, the rejections cannot be maintained.

In view of the above, Applicant believes that each of the rejections is improper and should be withdrawn and that the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the attorney/agent overseeing the application file, Juergen Krause-Polstorff, of NXP Corporation at (408) 474-9062 (or the undersigned).

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